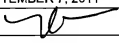
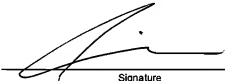


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1001.2346101	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>SEPTEMBER 7, 2011</u> Signature 		Application Number 10/645,055	Filed AUGUST 21, 2003
First Named Inventor DOUGLAS A. DEVENS, Jr.		Art Unit 3763	Examiner VICTORIA P. CAMPBELL
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 41,376 Registration number</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			


 Signature
 J. SCOT WICKHEM
 Typed or printed name
 612.677.9050
 Telephone number
 9/7/2011
 Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PRE-APPEAL CONFERENCE BRIEF

Dear Sir:

Applicants submit that the Examiner's rejections contain at least the following clear errors and/or omissions of one or more essential elements needed for a prima facie rejection.

Claims 49, 50, 53-61 and 64-68 have been finally rejected under 35 U.S.C. § 112, ¶ 1 as failing to comply with the written description requirement.

It was asserted in the Office Action and in the Advisory Action that the claims contain subject matter which was not described in the originally filed specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed subject matter. For example, regarding independent claims 49, 60 and 68, the Office Action indicates that “there is no discussion of the thickness of the outer layer of the balloon in the specification” and that “[i]f applicant is relying upon the drawings (specifically elected Figure 2) to support this limitation, the examiner notes that, as no mention that the figures are drawn to scale is given, the drawings cannot be relied upon to support [the limitations of these claims]” (emphasis added). Applicants respectfully disagree.

MPEP § 2163 provides guidelines for the examination of applications under 35 U.S.C. § 112, first paragraph. To satisfy the written description requirement, a patent application “must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention”. MPEP § 2163-1 (emphasis added). “An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.” *Id.* citing *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) (emphasis added). Further, “the description of [an] article pictured can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art.” MPEP § 2125; *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977) (note, although MPEP § 2125 concerns prior art figures, the discussion is relevant for what figures are capable of teaching one having ordinary skill in the art). Moreover, the subject matter of the claims need not be described literally in order for the disclosure to comply with the description requirement. MPEP § 2163.02 (emphasis added).

In other words, the MPEP indicates that the written description requirement may be satisfied by the figures.

In this case, the claimed invention can be seen in the figures (e.g., FIG. 2). For example, claim 49 recites that the inner layer has a greater thickness in the body portion than in the proximal waist and that the outer layer has a lesser thickness in the body portion than in the proximal waist. These features are clearly seen in FIG. 2.

Regardless of whether or not the figures are drawn precisely to scale, the fact that relative differences in the thicknesses of various portions of the claimed balloons are seen in the drawings demonstrates to persons having ordinary skill in the art that Applicants had possession of the claimed invention at the time of filing the application. FIG. 2 shows the claimed features and it is clear error to indicate a person having ordinary skill would not reasonably recognize such features as being present from the face of FIG. 2 and particularly, when FIG. 2 is combined with the detailed description of the specification.

It also appears to be a clear error for the Office to continue to require that the specification indicate the figures are “drawn to scale” in order for Applicants to be able to utilize those figures to support claim amendments concerning relative sizes of features in the claims, as there is no such requirement in the MPEP or 37 C.F.R. This is particularly evident when the originally filed specification actually does discuss relative thicknesses of the outer layer compared to the inner layer and total thickness of the layers. For example, and contrary to the Office’s assertion in the Advisory Action, the specification at page 5, line 26 through page 6, line 7 provides examples of relative dimensions for layers 26/28 at different portions of the balloon. (Note, the text of US 2005/0043679 A1 is not consistent with the originally filed text of U.S. App. Ser. No. 10/645,055). From this disclosure, it can be appreciated that the specification does disclose that the balloon may include layers having the structural features/configurations set forth in the claims. Indeed, balloon configurations can be readily gleaned from the specification including those that include the features recited in the claims. Therefore, not only do the figures provide support for the claimed invention, the specification also provides support sufficient to satisfy the written description requirement.

Based on these remarks, Applicants respectfully submit that the claimed features of “wherein the outer layer has a lesser thickness in the body portion than in the [proximal or distal]

waist” are supported by the originally filed application in a manner that complies with the written description requirement. Accordingly, Applicants respectfully submit that the rejection of claims 49, 60, and 68, as well as those claims depending therefrom, is a clear error.

Respectfully submitted,
DOUGLAS A. DEVENS, Jr. et al.

By their Attorney,

Date: _____

9/7/2011



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